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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,512	04/05/2007	Christian Funke	2400.0370000/VLC/CMB	4985

26111 7590 06/02/2010  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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06/02/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,512	<b>Applicant(s)</b> FUNKE ET AL.	
	<b>Examiner</b> John Pak	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/06, 7/07, 11/09</u> . | 6) <input type="checkbox"/> Other: _____  |

Claims 1-5, 7-14 are pending in this application.

Applicant's election, filed on 2/24/2010, of the invention of Group XXIX and compound I-1 as the single disclosed species of compound of formula (I) and compound II-1-4 as the single disclosed species of compound of formula (II) is acknowledged.

Applicant's only argument with the lack of unity of invention as determined in the Office action of 12/30/2009 is that claims 11-14 should be examined with invention Group XXIX because the formulas there are readable thereon. Applicant is advised that all currently pending claims 1-5 and 7-14 will presently be examined *to the extent that they read on the elected subject matter, supra*.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of WO 03/015518 and Fischer et al. (US 5,262,383) in view of Fischer et al. (US 2003/0100604) and Fischer et al. (US 2003/0114312).

WO 03/015518 discloses the pesticidal properties of applicant's compound II-1-4, which is equivalent to compound 531 in WO 03/015518. See Example 11 on page 42; see also page 115, compound 531, and excellent biological test results on pages 128-138 for compound 531. See also the claims of WO 03/015518. Formulation with various agricultural formulation excipients and adjuvants are disclosed (pages 89-91).

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Activity against a variety of pests is disclosed (pages 92-96). Combination with other pesticides is disclosed, wherein spiromesifen, BSN 2060, is disclosed (page 97, lines 5-6). Active ingredient amount of 0.01-99 wt% is disclosed (page 89, see table).

Fischer et al. ('383 patent) disclose spiromesifen in columns 29-30, the 14<sup>th</sup> compound. A broad spectrum insecticidal and acaricidal activity is disclosed, including control of animal pests (column 127, line 30 to column 130, line 21; see in particular column 127, line 31 and column 128, lines 52-58). Formulation with excipients is disclosed (column 130, line 27 to column 131, line 24; in particular, column 130, line 40, "surface active agents"). Formulation with other active compounds such as insecticides is disclosed (column 131, lines 28-32). Active ingredient amount of 0.1 to 95 wt% is disclosed (column 131, lines 24-26).

The two secondary references by Fischer et al. are cited to show that spiromesifen (applicant's elected compound I-1) has been taught to combine beneficially and synergistically with numerous structurally divergent pesticides against broad spectrum of pests. See in US 2003/0100604, paragraphs 4-109, 148-168; and in US 2003/0114312, paragraphs 3-183, 222-242.

The difference between the claimed invention and the cited prior art references is that there is no specific exemplified combination of spiromesfen + II-1-4. However, WO 03/015518 discloses the mixture, as discussed above. The motivation to specifically select these two ingredients arise from their known individual active pest control activities, and the fact that combining the two would be expected to provide improved pest control. Further motivation arises from the fact that spiromesifen is not only taught

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to be combined with other insecticides (Fischer et al., US 5,262,383), but also from the fact that spiromesifen has been known to be advantageously combined with so many other known insecticides (Fischer et al. references US 2003/0100604 and US 2003/0114312). As a result, there would have been sufficient motivation and suggestion for one of ordinary skill in the art to combine spiromesifen with II-1-4, as claimed.

In this regard, applicant's specification data has been reviewed, but the data there cannot be considered sufficient evidence of nonobviousness. First, it must be noted that evidence of nonobviousness, if any, must be commensurate in scope with that of the claimed subject matter. In re Kulling, 14 USPQ2d 1056, 1058 (Fed. Cir. 1990); In re Lindner, 173 USPQ 356, 358 (CCPA 1972). Here, structural variations for compounds of formulae I and II are so numerous and significant that it takes more than eight pages to list them all – see claim 1. The page numbers are merely indicative of the thousands of structurally divergent compounds encompassed by the instant claims. Further, applicant has provided no data for I-1 + II-1-4. Thus, there is no data with respect to the elected subject matter.

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention and the claimed invention as a whole have been fairly disclosed or suggested by the teachings of the cited references.

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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to JOHN PAK whose telephone number is **(571)272-0620**. The Examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's SPE, Johann Richter, can be reached on **(571)272-0646**.

The fax phone number for the organization where this application or proceeding is assigned is **(571)273-8300**. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Pak/  
Primary Examiner, Art Unit 1616